

Notice of Allowability

Application No.

10/764,235

Examiner

Agnes B. Rooke

Applicant(s)

O'MAHONY ET AL.

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 07/03/2006. (*RCE Request*)
2. ☒ The allowed claim(s) is/are 2,4,6-8,11,13-15 and 19-22.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>Sept 1, 2006</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

Examiner's Amendment

An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Kelly on September 1, 2006.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/03/2006 has been entered.

In view of reconsideration of the claims after amendments filed in the RCE examiner further restricts the claims as follows:

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2, 4, 6-11, 13-15, 19-22, drawn to a peptide of SEQ ID NO:24 and a method of using the peptide, classified in class 530, subclass 350.
- II. Claim 12, drawn to a method of using DNA, classified in class 435, subclass 96.1.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of Group I refer to a peptide and a method of using eth peptide and Group II refers to a method of using DNA. Therefore, the inventions are distinct.

During the on-phone interview on September 1, 2006, with Mr. Kelly, Applicant elected Group I without traverse . Therefore, claim 12 is withdrawn and then cancelled. Further, the agent gave the permission to amend the claims as follows:

Amendment to specification: On page 1 of the specification, line 11, after the word "2000" insert — **now U.S. Patent 6,780,846**, --

Amendment to the Claims:

1. Claim 2, line 1, delete ~~—an—~~and insert ~~—the—~~
2. Claim 2, line 2, after the "SEQ ID NO:24" insert ~~—and a carrier.—~~
3. Claim 4, line 1, after "active agent" insert ~~—selected from the group consisting of therapeutic agent, prophylactic agent, and diagnostic agent, —~~
4. Claim 6, line 1, after "active particle" insert -- **selected from the group consisting of nanoparticle, liposome, and microparticle, --**
5. Claim 7, line 1, after "active agent" insert -- **selected from the group consisting of therapeutic agent, prophylactic agent, and diagnostic agent, --**
6. Claim 8, line 1, after "active particle" insert -- **selected from the group consisting of nanoparticle, liposome, and microparticle, --**
7. Claim 8, line 2, delete ~~—4—~~and insert ~~—6--~~
8. Claim 11, line 3, delete ~~—4—~~and insert ~~—15—~~

9. Cancel Claim 12.
10. Claim 19, line 2, delete ~~—an—~~ and insert ~~—the—~~
11. Claim 19, after the "SEQ ID NO:24" insert ~~—and a carrier.--~~

Allowable subject matter

Claims **2, 4, 6-8, 11, 13-15, and 19-22** are allowed in view of the amendments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rookie whose telephone number is 571-272-2055.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MARYAM MONSHIPOURI, PH.D.
PRIMARY EXAMINER